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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,896	10/15/2001	Cheol-Woong Lee	205,330	3473
826	7590	04/19/2005	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			POPHAM, JEFFREY D	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/977,896	LEE, CHEOL-WOONG ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Popham	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Remarks

Claims 1-9 are pending.

Claim Objections

1. Claims 2, 3, 8, and 9 are objected to under 37 CFR 1.75(a) because of the following informalities:

- Claims 2, 3, 8, and 9, line 2: "distribution" should be "redistribution".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crill et al. (U.S. Patent 6,445,822) in view of Gutberlet (Gutberlet, L., "Peer-to-Peer Computing - A Technology Fad or Fact ? -", 10/10/2000, pp. 1-16).

Regarding Claim 1,

Crill et al. disclose a method of preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network, comprising:

a) collecting an illegally produced digital music file, which is derived from a record of a cooperating record corporation, by searching the network (Column 2, lines 53-56; and Column 16, lines 33-41).

Crill et al. do not disclose encrypting the collected digital music file with a predetermined key or redistributing the encrypted digital music file through the network.

Gutberlet, however, discloses b) encrypting the collected digital music file with a predetermined key (Pages 7-8, Section 3.1.1 Digital Rights Management (DRM)) and c) redistributing the encrypted digital music file through the network (Pages 7-8, Section 3.1.1 Digital Rights Management (DRM)). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the DRM system of Gutberlet into the searching system of Crill et al. in order to protect the copyrights of an entity through licensing and distribution of keys.

Regarding Claim 2,

Crill et al. do not disclose that the steps of collection and redistribution of the digital music file are performed by using a popular digital file sharing program.

Gutberlet, however, discloses that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing program (Pages 3-4, Section 2.1.2 The Hybrid Model

(Napster); and Pages 13-14, Section 4.3 An Agent Watching for Micropayments). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the P2P system of Gutberlet into the searching system of Crill et al. in order to provide a directory server that the user must connect to in order to obtain location information for a certain piece of data, thus enabling tracking of downloads.

Regarding Claim 3,

Crill et al. do not disclose that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing server.

Gutberlet, however, discloses that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing server (Pages 3-4, Section 2.1.2 The Hybrid Model (Napster); and Pages 13-14, Section 4.3 An Agent Watching for Micropayments). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the P2P system of Gutberlet into the searching system of Crill et al. in order to provide a directory server that the user must connect to in order to obtain location information for a certain piece of data, thus enabling tracking of downloads.

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2. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crill et al. (U.S. Patent 6,445,822) in view of Gutberlet (Gutberlet, L., "Peer-to-Peer Computing - A Technology Fad or Fact ? -", 10/10/2000, pp. 1-16), further in view of Schneier (Schneier, B., "Applied Cryptography", 1996, Volume 2, pp. 4-5).

Regarding Claim 4,

Crill et al. as modified by Gutberlet does not disclose that at step b) the collected digital music file is encrypted by a public key encryption algorithm.

Schneier, however, discloses that at step b) the collected digital music file is encrypted by a public key encryption algorithm (Pages 4-5, Section Public-Key Algorithms). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the encryption method of Schneier into the searching system of Crill et al. as modified by Gutberlet in order to obtain a secure form of encryption, in which only the desired party holding the proper private key can decrypt the information being sent.

Regarding Claim 5,

Crill et al. as modified by Gutberlet does not disclose that at step b) the collected digital music file is encrypted by a public key encryption algorithm.

Schneier, however, discloses that at step b) the collected digital music file is encrypted by a public key encryption algorithm (Pages 4-5,

Section Public-Key Algorithms). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the encryption method of Schneier into the searching system of Crill et al. as modified by Gutberlet in order to obtain a secure form of encryption, in which only the desired party holding the proper private key can decrypt the information being sent.

Regarding Claim 6,

Crill et al. as modified by Gutberlet does not disclose that at step b) the collected digital music file is encrypted by a public key encryption algorithm.

Schneier, however, discloses that at step b) the collected digital music file is encrypted by a public key encryption algorithm (Pages 4-5, Section Public-Key Algorithms). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the encryption method of Schneier into the searching system of Crill et al. as modified by Gutberlet in order to obtain a secure form of encryption, in which only the desired party holding the proper private key can decrypt the information being sent.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crill et al. (U.S. Patent 6,445,822) in view of Cooperman et al. (U.S. Patent 5,613,004).

Crill et al. disclose a method of preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network, comprising:

a) collecting an illegally produced digital music file, which is derived from a record of a cooperating record corporation, by searching the network (Column 2, lines 53-56; and Column 16, lines 33-41).

Crill et al. do not disclose inserting a watermark containing a predetermined secret information in the collected digital music file or redistributing the watermarked digital music file through the network.

Cooperman et al., however, disclose b) inserting a watermark containing a predetermined secret information in the collected digital music file (Column 15, lines 33-35) and c) redistributing the watermarked digital music file through the network (Column 15, lines 36-37). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the watermarking method of Cooperman et al. into the searching system of Crill et al. in order to be able to determine who the copy is licensed to, so that proper action can be taken (Column 15, lines 39-53).

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crill et al. (U.S. Patent 6,445,822) in view of Cooperman et al. (U.S. Patent 5,613,004), further in view of Gutberlet (Gutberlet, L., "Peer-to-Peer Computing - A Technology Fad or Fact ? -", 10/10/2000, pp. 1-16).

Regarding Claim 8,

Crill et al. as modified by Cooperman et al. does not disclose that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing program.

Gutberlet, however, discloses that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing program (Pages 3-4, Section 2.1.2 The Hybrid Model (Napster); and Pages 13-14, Section 4.3 An Agent Watching for Micropayments). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the P2P system of Gutberlet into the searching system of Crill et al. as modified by Cooperman et al. in order to provide a directory server that the user must connect to in order to obtain location information for a certain piece of data, thus enabling tracking of downloads.

Regarding Claim 9,

Crill et al. as modified by Cooperman et al. does not disclose that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing server.

Gutberlet, however, discloses that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing server (Pages 3-4, Section 2.1.2 The Hybrid Model (Napster); and Pages 13-14, Section 4.3 An Agent Watching for

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Micropayments). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the P2P system of Gutberlet into the searching system of Crill et al. as modified by Cooperman et al. in order to provide a directory server that the user must connect to in order to obtain location information for a certain piece of data, thus enabling tracking of downloads.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANDREW CALDWELL
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